

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following amendment and remarks. By virtue of the amendments above, claims 1, 4, 7-9, 14, 21, and 23 have been amended. Support for the claim amendments may at least be found in the original specification at page 9, lines 12-22, page 10, lines 7 and 8, page 12, lines 1-4, and page 14, lines 14-18. Claims 18-20 and 24-26 were withdrawn from consideration as being drawn to a non-elected species and have been canceled without prejudice or disclaimer of the subject matter therein. Thus, claims 1-17 and 21-23 are pending in the present application, of which claims 1, 14, and 21 are independent.

Claims 21-23 were rejected under 35 U.S.C. §101 as being allegedly directed to non-statutory subject matter.

Claims 1-17 and 21-23 were rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-2, 7-17 and 21-23 were rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Andrews et al. (US 7,020,698, "Andrews").

Claims 3-9 and 23 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Andrews and further in view of Harvey et al. (U.S. 2004/0054807, "Harvey").

Drawings

The indication that the drawings submitted on January 30, 2004 have been approved is noted with appreciation.

Information Disclosure Statement

The indication that the documents cited in the Information Disclosure Statement (IDS) filed on January 30, 2004 and the IDS filed on September 16, 2005 have been considered is noted with appreciation.

Claim Rejection Under 35 U.S.C. §101

Claims 21-23 are rejected under 35 U.S.C. §101 as being allegedly directed to non-statutory subject matter. More specifically, the Office Action at page 2 asserts that the applicant's specification at paragraph 86 shows that a computer readable medium as recited in claims 21-23 is not limited to a tangible medium. Claim 21 has been amended to recite "Computer software on a **tangible** computer readable medium" and thus clearly recites a tangible computer readable medium. Thus, the foregoing rejection has been rendered moot and withdrawal thereof is respectfully requested.

Claim Rejection Under 35 U.S.C. §112

Claims 1-17 and 21-23 were rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is traversed and/or overcome for the following reasons.

As to the rejection of claims 1, 14, and 21 as having insufficient antecedent basis for the term "the candidate nodes," claims 1, 14, and 21 recite "a set of candidate nodes" on lines

3, 2, and 3, respectively. As such, claims 1, 14, and 21 provide sufficient antecedent basis for the subsequently recited term “the candidate nodes.”

As to the rejection of claim 4 asserting that the term “approximately” in claim 4 is a relative term, the term has been deleted from claim 4.

For at least the above-described reasons, withdrawal of the rejection of claims 1-17 and 21-23 under 35 U.S.C. §112, second paragraph, as being indefinite is respectfully requested.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1-2, 7-17 and 21-23

Claims 1-2, 7-17 and 21-23 were rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Andrews. This rejection is respectfully traversed for at least the following reasons.

Amended claim 1 recites a method of identifying at least one node close to a first node in a network, the method comprising, inter alia:

selecting a set of candidate nodes from a plurality of nodes based on location information for the candidate nodes and the first node, wherein the selection is made based on comparing distances from each of the first node and the plurality of nodes to each one of a plurality of global landmark nodes.

Andrews fails to teach a selection of a set of candidate nodes, where the selection is made based on comparing distances from each of a first node and a plurality of nodes to each one of a plurality of global landmark nodes. The Office Action at page 4 cites Abstract and, from column 4, line 8, to column 5, line 18, of Andrews and asserts that Andrews “discloses selecting closest server based on distance from group of content server.” However, such selection of a closest server in Andrews fails to teach that the selection of the closest server is made based on comparing distances from each of a plurality of nodes to each of servers of Andrews. In Andrews, there is no disclosure that distances to a same server from each of a plurality of nodes is compared. The rest of Andrew’s disclosure fails to cure the foregoing deficiencies of Andrews. Thus, Andrews fails to teach a selection of a set of candidate nodes, where the selection is made based on comparing distances from each of a first node and a plurality of nodes to each one of a plurality of global landmark nodes, as discussed-above for claim 1.

Thus, for at least the foregoing reasons, Andrews fails to teach all of the features of independent claim 1 and its dependent claims and thus cannot anticipate these claims. The Examiner is therefore respectfully requested to withdraw the rejection of claim 1 and claims that depend therefrom and to allow these claims.

Independent claims 14 and 21 each recite features similar to those discussed above for claim 1 as follows. Claim 14 recites “means for selecting a set of candidate nodes from a plurality of nodes . . . , wherein the selection is made based on comparing distances from each of the first node and the plurality of nodes to each one of a plurality of global landmark nodes. Claim 21 recites “selecting a set of candidate nodes . . . , wherein the selection is made based on comparing distances from each of the first node and the plurality of nodes to each one of a plurality of global landmark nodes.” Thus, for at least the same reasons set forth earlier with respect to claim 1, Andrews fails to teach all of the features of independent claims 14 and 21 and their respective dependent claims and thus cannot anticipate these claims. The Examiner is therefore respectfully requested to withdraw the rejection of claims 14 and 21 and claims that depend therefrom and to allow these claims.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S., 82 USPQ2d 1385 (2007):

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter

sought to be patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 3-9 and 23

Claims 3-9 and 23 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Andrews in view of Harvey. This rejection is respectfully traversed for at least the following reasons.

Claims 3-9 depends from claim 1, and claim 23 depends from claim 21. Thus, for at least the same reasons set forth with respect to claims 1 and 21, Andrews fails to teach or suggest the above-recited features of claims 1 and 21.

Harvey fails to overcome the above-discussed deficiencies of Andrews. More specifically, the Office Action at page 8 relies on Harvey as showing features related to a distributed hash table overlay network recited in claim 3. However, such features of Harvey and the rest of Harvey's disclosure fail to teach or suggest the above-recited features of claim 1.

Thus, for at least the above-discussed reasons, the proposed combination of Andrews and Harvey fails to teach or suggest the above-discussed features of claim 1 and 21. It is respectfully submitted that the Office Action *failed* to establish a *prima facie* case of obviousness against claims 3-9 and 23. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 3-9 and 23 and to allow these claims.

PATENT

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Conclusion

In light of the foregoing, withdrawal of the requirement and examination of all of the claims of this application are respectfully requested.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to this application, please contact the undersigned at the at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

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